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10/690,876

10/22/2003

Robert Leon Benedict

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04/05/2006

THE GOODYEAR TIRE & RUBBER COMPANY
INTELLECTUAL PROPERTY DEPARTMENT 823
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AKRON, OH 44316-0001

EXAMINER

FUREMAN, JARED

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,876

Applicant(s)

BENEDICT, ROBERT LEON

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-18 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the appeal brief, filed on 1/23/2006, which has been entered in the file. Claims 1-18 are pending.

1. In view of the appeal brief filed on 1/23/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claim Objections

2. Claim 3 is objected to because of the following informalities: Claim 3, lines 2-3 reads, "... steps c and d are conducted by a tire supplier; and steps d, e and f are conducted by a vehicle manufacturer." (emphasis added). The claim recites that step d is conducted by both a tire supplier and a vehicle manufacturer. Paragraphs 75 and 79,

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of applicant's specification, and figure 17, step 420, indicate that step d is conducted by the tire supplier. Thus, for examination purposes, claim 3 has been interpreted to read, "... steps c and d are conducted by a tire supplier; and steps e and f are conducted by a vehicle manufacturer". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hardman et al (US 2002/0126005 A1, previously cited).

Hardman et al teaches a method for integrating tire identification data and vehicular identification data, comprising the steps: a. manufacturing tire tag means (tire tag 14, figure 1A, the step of manufacturing tire tag 14 is necessarily present) having data retention tag memory (memory device 16, figure 1A and paragraph 56); b. writing tag means identification data into tag memory (the tag contains a unique tag number, which is installed by the tag manufacturer, paragraph 95); c. affixing the tag means to a tire (the tag 14 is affixed to tire 10, figure 1A, paragraphs 55 and 75); d. writing tire identification data identifying the tire into the tag memory (a tire identification number is

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programmed into the tag, paragraph 96); e. associating the tire with a specific vehicle (a vehicle 12 associated with tire 10, figure 1A, paragraph 56, the step of associating the tire with a specific vehicle is necessarily present, since Hardman et al teaches the vehicle 12 and tire 10 are associated); f. reading the tire identification data from the tag memory into a vehicle data retention memory (the tire tag 14 is read by a receiver/transmitter unit 30A and data from the tire tag is stored in user interface 48, which, in at least one embodiment, resides on the vehicle, figure 12 and paragraphs 78-80. Since the user interface 48 is mounted on the vehicle and stores tag data, which includes vehicle number, the user interface may be considered a vehicle data retention memory); further comprising the step of uploading the tire identification data from the vehicle data retention memory to an archive database (the user interface 48 routes tag data to external system 50, which maintains a database of archive tag data, see figure 12 and paragraphs 79 and 80); further comprising the steps of calibrating tag functions; and including tag functions calibration data into the tag means identification data (the reader can request calibration coefficients for the sensors to be transmitted, see paragraph 120, thus, the step of calibrating tag functions and including calibration data into the tag identification data is necessarily present); further comprising the steps: reading the tire identification data from the vehicle data retention memory (reading the tag data from the user interface 48 to the external system 50, paragraph 80), and rewriting a vehicle identification code from the vehicle (writing and erasing user data, paragraphs 98 and 105, the user data is erased when the tire changes owners, the new owner would write a new vehicle number); the step of manufacturing the tag means to

include a transponder (RF circuit 21, figure 1A and paragraph 56) and antenna assembly (tire tag antenna 20, figure 1A and paragraph 56); the step of manufacturing the antenna in an annular form coupled to the transponder (the antenna may include inductors 20E, which are shown in annular form in figure 1D, also see paragraph 64); further comprising the step of writing a vehicle identification code identifying the specific vehicle into the tag memory (a vehicle number is written into the tire tag, paragraph 98).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardman et al in view of the admitted prior art.

The teachings of Hardman et al have been discussed above. Hardman et al also teaches the steps a and b are conducted by a tire tag means supplier (the tire tag is necessarily manufactured by a tire tag manufacturer and Hardman et al teaches that the tag identification number is installed by a tag manufacturer, see paragraph 95); steps c and d are conducted by a tire supplier (Hardman et al describes mounting the tag to a tire, see paragraph 55, which, at least in one embodiment ("Method for Embedding a Monitoring Device Within a Tire During Manufacture") is conducted by a tire manufacturer. Hardman et al also teaches that the tire identification number is

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programmed in the tag by the tag installer, see paragraph 96, which, in at least one embodiment, would be the tire manufacturer). As discussed above, Hardman et al also teaches step f.

Hardman et al fails to specifically teach steps e and f are conducted by a vehicle manufacturer.

The admitted prior art teaches that tires, having a transponder and tire tag operatively coupled thereto, are transferred to an original equipment manufacturer and mounted to a production line vehicle (see paragraph 5 of applicant's specification).

In view of the admitted prior art, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the method as taught by Hardman et al, steps e and f are conducted by a vehicle manufacturer, in order to provide a vehicle with tires and ensure that the tire tag and user interface are functioning properly before selling the vehicle to a customer, thereby insuring customer satisfaction.

Allowable Subject Matter

7. Claims 9-18 have been allowed over the prior art of record.
8. The following is an examiner's statement of reasons for the indication of allowable subject matter and reasons for allowance: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: (re claim 9) uploading tire identification data from the electronic control unit of the vehicle to an OEM database; and (re claim

13) uploading the tire identification data from the ECU data storage means to an OEM database; in combination with the other claimed limitations as set forth in the claims.

Applicant's arguments, see page 7, lines 6-20, filed 1/23/2006, with respect to the combination of the prior art and admitted prior art have been fully considered and are persuasive. The 103(a) rejection of claims 9-18 has been withdrawn.

While Hardman et al teaches uploading tire tag data from the user interface 48 to an archive database at external system 50 (see paragraphs 79 and 80), Hardman et al fails to specifically teach the database being an OEM database. Further, paragraph 81 of Hardman et al suggests that the system 50 is a customer/user system or location. Therefore, without the benefit of applicant's teachings, it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine or modify the prior art in a manner so as to create the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

9. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. Please note that a new interpretation of the Hardman et al reference has been applied to claims 1-8.

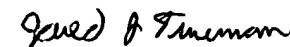
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Juzswik (US 7,015,801), Ichinose (US 7,019,628), Stewart et al (US 7,010,968), Forster et al (US 7,015,802), Katou (US 6,999,861) and Norman et al (US 6,972,671) all teach tire tag systems and methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jared J. Fureman
Primary Examiner
Art Unit 2876

April 3, 2006


MICHAEL G. LEE
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